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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,061

03/21/2006

Raanan Ben-Horin

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05/12/2008

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EXAMINER

ANDERSON, DENISE R

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

05/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/573,061</p>	<p>Applicant(s) BEN-HORIN, RAANAN</p>	
	<p>Examiner Denise R. Anderson</p>	<p>Art Unit 1797</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Claims 1 and 5 under 103(a) over Sadan et al. (US 6,398,037 B1).
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1 and 3-6.
Claim(s) withdrawn from consideration: 2.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant cancelled claim 2 and incorporated it in to claim 1, raising no new issues that would require further consideration and/or search. Applicant made arguments that were already addressed in the previous office action plus one new one. Applicant argued that *Nerwin v. Erlichman*, 168 USPQ 177, 179 did not stand for the proposition that constructing a formerly integral structure in various elements involves only routine skill in the art. The examiner made two arguments for the unpatentability of the claims, one of which included the *Nerwin v. Erlichman* cite. Though it is not required, the examiner will address the new argument here to move the prosecution along.

Quote from *Nerwin v. Erlichman*, 168 USPQ 177, 178 - The issue:

In issue is Erlichman's right to make in count 1 the limitations (1) "a divider between said exposure and processing chamber" and (2) "means effective upon movement of said strip along said first path for directing the leading edge of each said sheet along a second path branching from said first path * * * into said exposure chamber."

Nerwin in effect contends that these limitations set forth two separate elements, that he discloses a divider comprising the roller 44 and the wall 34, that in his disclosure "the directing means comprises stripper 43," that in Erlichman's disclosure of Figure 10 these limitations find support only in the structure 198, that that structure is a single element, and that Erlichman "may not use this single element to meet two positively stated and separately claimed elements of the count."

Quote from *Nerwin v. Erlichman*, 168 USPQ 177, 179 - The holding is supported by Supreme Court and CCPA precedent:

The mere fact that a given structure is integral does not preclude its consisting of various elements. In *Howard et al. v. Detroit Stove Works*, 150 U.S. 164, 65 O.G. 1765, 1893 C.D. 659, the Supreme Court pertinently stated:

"* * * the Monumental grate * * * contains all the elements of the Beckwith grate, except that * * * it is cast in two pieces, while the Beckwith grate is cast in one piece." [Emphasis added.]

In *Reed v. Edwards*, 26 CCPA 901, 101 F.2d 550, 505 O.G. 234, 1939 C.D. 291, 40 USPQ 620, the court stated:

"* * * with reference to the statement [of the Board of Appeals] that the same element may be relied upon for performing two functions, we express no opinion thereon with respect to the application of that rule as applied to the counts before us. We are of the opinion, however, that while a given structure may in one sense be considered a single element, in another sense it may be so formed as to consist of several elements depending upon the functions to be performed by such elements."

In summary, the examiner maintains that *Nerwin v. Erlichman* stands for the proposition that constructing a formerly integral structure in various elements involves only routine skill in the art.

With regards to the objection to Figure 2, the amended drawing reached the examiner and the previous objection will be withdrawn of not showing every feature of the invention specified in the claims. Unfortunately, a new objection to amended Figure 2 will be made due to the minor informality that a middle character in the each of the lines "FIG. 2", "160", and "161" is well below the rest of the font line.

At this point in the prosecution, applicant's amendments have not materially reduced or simplified issues for appeal but neither have they raised new issues that would require further consideration and/or search. Therefore, the amendments will be entered. Amended claim 1 (which incorporates previously presented claim 2) and previously presented claims 3-6 will be rejected as in the final office action.